



13281 U.S. PTO

031804

PATENT  
Customer Number 22,852  
Attorney Docket No. 4995.0053-01

22858 U.S. PTO  
10/802823



031804

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Mail Stop Patent Application**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Prior Application Art Unit: 1642

Prior Application Examiner: S. Rawlings

SIR: This is a request for filing a

☒ Continuation ☐ Continuation-in-Part ☐ Divisional Application under 37 C.F.R. § 1.53(b) of pending prior Application No. 09/534,072 filed March 24, 2000, of Shiv SRIVASTAVA, Vasantha SRIKANTAN, Zhiqiang ZOU and Judd MOUL for :  
PROSTATE SPECIFIC GENE, PCGEM1, AND METHODS OF USING PCGEM1 TO  
DETECT, TREAT, AND PREVENT PROSTATE CANCER

1. ☒ Enclosed is a complete copy of the prior application including the oath or Declaration and drawings, if any, as originally filed. I hereby verify that the attached papers are a true copy of prior Application No. 09/534,072 as originally filed on March 24, 2000, which is incorporated herein by reference.
2. ☐ Enclosed is a substitute specification under 37 C.F.R. § 1.125. The undersigned hereby verifies that no new matter is added in this substitute specification.
3. ☐ Enclosed is a Request for Non-Publication of Application and Certification Under 35 U.S.C. § 122(b)(2)(B)(i).
4. ☒ A Preliminary Amendment is enclosed, including Attachments A-C.
5. ☒ The filing fee is calculated on the basis of the claims existing in the prior application as amended in the Preliminary Amendment filed herewith.

Basic Application Filing Fee					\$770	\$ 770.00
	Number of Claims		Basic	Extra Claims		
Total Claims	25	-	20	5	x \$18	90.00
Independent Claims	3	-	3	0	x \$86	0.00
<input type="checkbox"/> Presentation of Multiple Dep. Claim(s)					+\$290	0.00
Subtotal						\$ 860.00
Reduction by 1/2 if small entity						- 430.00
TOTAL APPLICATION FILING FEE						\$ 430.00

6. ☒ A check in the amount of \$430.00 to cover the filing fee is enclosed.
7. ☒ The Commissioner is hereby authorized to charge any fees which may be required including fees due under 37 C.F.R. § 1.16 and any other fees due under 37 C.F.R. § 1.17, or credit any overpayment during the pendency of this application to Deposit Account No. 06-0916.
8. ☒ New acceptable drawings are enclosed.
9. ☒ The prior application is assigned of record to: Henry M. Jackson Foundation for the Advancement of Military Medicine recorded at Reel/Frame 011105/0308, Reel/Frame 010929/0928, and Reel/Frame 010929/0946.
10. ☒ Priority of Application No.60/126,469, filed on March 26, 1999 is claimed under 35 U.S.C. § 119.
11. ☒ Small entity status is appropriate and applies to this application.
12. ☒ The power of attorney in the prior application is to at least one of the following: FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P., Douglas B. Henderson, Reg. No. 20,291; Ford F. Farabow, Jr., Reg. No. 20,630; Arthur S. Garrett, Reg. No. 20,338; Donald R. Dunner, Reg. No. 19,073; Brian G. Brunsvold, Reg. No. 22,593; Tipton D. Jennings, IV, Reg. No. 20,645; Jerry D. Voight, Reg. No. 23,020; Laurence R. Hefter, Reg. No. 20,827; Kenneth E. Payne, Reg. No. 23,098; Herbert H. Mintz, Reg. No. 26,691; C. Larry O'Rourke, Reg. No. 26,014; Albert J. Santorelli, Reg. No. 22,610; Michael C. Elmer, Reg. No.

25,857; Richard H. Smith, Reg. No. 20,609; Stephen L. Peterson, Reg. No. 26,325; John M. Romary, Reg. No. 26,331; Bruce C. Zotter, Reg. No. 27,680; Dennis P. O'Reilley, Reg. No. 27,932; Allen M. Sokal, Reg. No. 26,695; Robert D. Bajefsky, Reg. No. 25,387; Richard L. Stroup, Reg. No. 28,478; David W. Hill, Reg. No. 28,220; Thomas L. Irving, Reg. No. 28,619; Charles E. Lipsey, Reg. No. 28,165; Thomas W. Winland, Reg. No. 27,605; Basil J. Lewris, Reg. No. 28,818; Martin I. Fuchs, Reg. No. 28,508; E. Robert Yoches, Reg. No. 30,120; Barry W. Graham, Reg. No. 29,924; Susan Haberman Griffen, Reg. No. 30,907; Richard B. Racine, Reg. No. 30,415; Thomas H. Jenkins, Reg. No. 30,857; Robert E. Converse, Jr., Reg. No. 27,432; Clair X. Mullen, Jr., Reg. No. 20,348; Christopher P. Foley, Reg. No. 31,354; Roger D. Taylor, Reg. No. 28,992; John C. Paul, Reg. No. 30,413; David M. Kelly, Reg. No. 30,953; Kenneth J. Meyers, Reg. No. 25,146; Carol P. Einaudi, Reg. No. 32,220; Steven M. Anzalone, Reg. No. 32,095; Jean B. Fordis, Reg. No. 32,984; Barbara C. McCurdy, Reg. No. 32,120; James K. Hammond, Reg. No. 31,964; Richard V. Burgujian, Reg. No. 31,744; J. Michael Jakes, Reg. No. 32,824; Thomas W. Banks, Reg. No. 32,719; Christopher P. Isaac, Reg. No. 32,616; Bryan C. Diner, Reg. No. 32,409; M. Paul Barker, Reg. No. 32,013; Andrew Chanhon Sonu, Reg. No. 33,457; David S. Forman, Reg. No. 33,694; Vincent P. Kovalick, Reg. No. 32,867; James W. Edmondson, Reg. No. 33,871; Michael R. McGurk, Reg. No. 32,045; Joann M. Neth, Reg. No. 36,363; Gerson S. Panitch, Reg. No. 33,751; Cheri M. Taylor, Reg. No. 33,216; Charles E. Van Horn, Reg. No. 40,266; Linda A. Wadler, Reg. No. 33,218; Jeffrey A. Berkowitz, Reg. No. 36,743; Michael R. Kelly, Reg. No. 33, 921; James B. Monroe, Reg. No. 33,971; Doris Johnson Hines, Reg. No. 34,629; Lori Ann Johnson, Reg. No. 34,498; R. Bruce Bower, Reg. No. 37,099; John Rissman, Reg. No. 33,764; Therese A. Hendricks, Reg. No. 30,389; Leslie I. Bookoff, Reg. No. 38,084; Michele C. Bosch, Reg. No. 40,524; Michael J. Flibbert, Reg. No. 33,234; Scott A. Herbst, Reg. No. 35,189; Leslie A. McDonell, Reg. No. 34,872; Thalia V. Warnement, Reg. No. 39,064; Ronald A. Bleeker, Reg. No. 27,773; Kathleen A. Daley, Reg. No. 36,116; C. Gregory Gramenopoulos, Reg. No. 36,532; Anthony M. Gutowski, Reg. No. 38,742; Yitai Hu, Reg. No. 40,653; Lionel M. Lavenue, Reg. No. 46,859; Christine E. Lehman, Reg. No. 38,535; Patrick J. Coyne, Reg. No. 31,821; F. Leslie Bessinger, III, Reg. No. 39,108; Houtan K. Esfahani, Reg. No. 41,893; Esther H. Lim, Reg. No. 41,994; Michael A. Morin, Reg. No. 40,734; Erik R. Puknys, Reg. No. 40,132; and Timothy B. Donaldson, Reg. No. 43,592.

13. ☒ The power appears in the original declaration of the prior application.

14. ☐ Since the power does not appear in the original declaration, a copy of the power in the prior application is enclosed.
15. ☒ Please address all correspondence to FINNEGAN, HENDERSON, FARABOW, GARRETT and DUNNER, L.L.P., 1300 I Street, N.W., Washington, D.C. 20005-3315, **Customer Number 22,852**.
16. ☐ Recognize as associate attorney \_\_\_\_\_
17. ☒ Also enclosed is Request for Transfer of Computer Readable Form Under 37 C.F.R. § 1.821(e); Original Sequence Listing from parent application dated March 24, 2000 and accompanying Statement to Support Filing and Submission in Accordance with 37 C.F.R. §§ 1.821-1.825; Request for Approval of Drawing Changes; Abstract; Information Disclosure Statement; PTO 1449; Submission of Formal Drawings

PETITION FOR EXTENSION. If any extension of time is necessary for the filing of this application, including any extension in parent Application No.09/534,072, filed March 24, 2000, for the purpose of maintaining copendency between the parent application and this application, and such extension has not otherwise been requested, such an extension is hereby requested, and the Commissioner is authorized to charge necessary fees for such an extension to our Deposit Account No. 06-0916. A duplicate copy of this paper is enclosed for use in charging the deposit account.

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: March 18, 2004

By: Timothy B. Donaldson  
Timothy B. Donaldson  
Reg. No. 43,592

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re **Rule 1.53(b) Cont.** Appln. of )  
U.S. Serial No. 09/534,072 )  
SRIVASTAVA et al. )  
Serial No. Not yet assigned ) Prior Group Art Unit: 1642  
Filed: March 18, 2004 ) Prior Examiner: S. Rawlings

For: PROSTATE SPECIFIC GENE, PCGEM1, AND METHODS OF USING  
PCGEM1 TO DETECT, TREAT, AND PREVENT PROSTATE CANCER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REQUEST FOR APPROVAL OF DRAWING CHANGES**

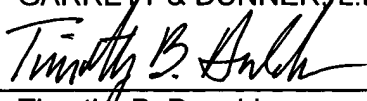
Subject to the approval of the Examiner, it is respectfully requested that Figure 8, in the above-captioned application, be amended by changing nucleotide 302 of SEQ ID NO:1 from a thymine base ("T") to a guanine base ("G"). This amendment is supported by the specification and has already been approved in the parent application 09/534,072. The change to Figure 8 is indicated in red in the annotated drawing sheet (Attachment B) attached to the Preliminary Amendment.

Applicants have submitted a formal drawing for Figure 8. The same change to Figure 8 was formally approved in the parent application S.N. 09/534,072 in a Form PTO-90C dated March 16, 2004 (Paper No. 37).

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: March 18, 2004

By:   
Timothy B. Donaldson  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re **Rule 1.53(b) Cont.** Appln. of                    )  
U.S. Serial No. 09/534,072                                )  
  )  
SRIVASTAVA et al.   )  
  )  
Serial No. Not yet assigned                                )       Prior Group Art Unit: 1642  
  )  
Filed: March 18, 2004                                        )       Prior Examiner: S. Rawlings

For: PROSTATE SPECIFIC GENE, PCGEM1, AND METHODS OF USING  
PCGEM1 TO DETECT, TREAT, AND PREVENT PROSTATE  
CANCER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**SUBMISSION OF FORMAL DRAWINGS**

Subject to the approval of the Examiner, please replace the informal drawings with the twenty-one (21) sheets of formal drawings filed herewith (Figures 1-4, 5A, 5B, 6A, 6B, 7A, 7B, 8-15, 16A, 16B and 17).

Applicants have submitted herewith a Request for Approval of Drawing Changes to modify Figure 8. The change is requested to correct a sequencing error and support for the amendment can be found in the specification. This same change was formally approved by the Examiner in the parent application S.N. 09/534,072 in a Form PTO-90C dated March 16, 2004 (Paper No. 37).

If the formal drawings for any reason are not in full compliance with the pertinent statutes and regulations, please so advise the undersigned.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully Submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Date: March 18, 2004

By: Timothy B. Donaldson  
Timothy B. Donaldson  
Reg. No. 43,592